

we said in *In re Cooke*, 28 C.C.P.A. (Patents) 910, 117 F.2d 749, 48 USPQ 560, 562:

It is our view that merely because appellant has succeeded in producing an article that is more perfect than any similar article shown in the cited prior art, it does not necessarily entitle him to a patent on the article. It may be that invention rests in certain novel features of the article, as is emphasized by some of the allowed claims, and it may also be that invention rests in the method of an apparatus for making the article, but surely it cannot rest alone in the degree of accuracy or perfection obtained by the employment of the method and apparatus.

See also *In re Merz*, 25 C.C.P.A. (Patents) 1314, 97 F.2d 599, 38 USPQ 143.

Certain of the claims also state that the article has a substantially constant density in a longitudinal direction. That limitation is also a matter of degree only and represents, at best, merely an improvement over the ordinary cast ingot in a characteristic known to be desirable. It follows that this limitation, like that as to smoothness, cannot impart patentability to the claims. *In re Cooke*, supra, and *In re Merz*, supra.

Claim 48 specifies that the variation in density is not more than about 0.07, but it is not shown that that limitation as to density is in any way critical. That claim, like the others, involves merely a matter of degree, so far as density is concerned.

Some of the claims, as in quoted claim 48, refer to the properties of the ingot in the condition "as cast." It is considered immaterial if an article has any given property, whether it had this property "as cast" or acquired it later by a machine process.

Claim 48 states that the article has "a thin skin of copper crystals in a matrix of copper-copper oxide eutectic covering the exterior thereof." The examiner held that that characteristic would be satisfied in a casting made in a stationary mold, if a copper composition containing oxygen were used. Appellants submitted no evidence to rebut that holding of the examiner. Accordingly, the quoted limitation in claim 48 cannot be held to lend patentability to that claim.

Although appellants place great emphasis in their brief on the alleged superiority of ingots made by the process and apparatus of their patents over ingots of the prior art, we are of opinion, for the reasons hereinbefore stated, that the appealed claims do not define patentable subject matter.

The decision of the Board of Appeals is, accordingly, affirmed.

By reason of illness, GARRETT, Presiding Judge, was not present at the argument of this case and did not participate in the decision.

34 C.C.P.A. (Patents) 1150

# Court of Customs and Patent Appeals

In re JONES

Appl. No. 5249 Decided June 17, 1947

## PATENTS

### 1. Claims—Broad or narrow—Chemical cases

In determining propriety of Markush grouping, compounds grouped must each be considered as whole and should not be broken down into elements or other components; in any Markush group, compounds will differ from each other in certain respects; differences must, to some extent, be weighed against similarities; whether group is proper must be decided in view of facts of each case; inclusion in Markush groups of compounds differing widely in some respects has been permitted.

### 2. Claims—Broad or narrow—Chemical cases

All claimed compounds belong to genus of tetralyl compounds having substituted methyl group at position 6, but it is not established that all members of genus would be suitable for applicant's purpose, so applicant cannot claim entire genus; it is necessary to limit Markush claims, which are allowed, to individual compounds known to possess desired property.

### 3. Claims—Duplicate or redundant

Addition of statement of use to claim to compound does not produce materially different claim, so claim is rejected as duplicate.

### 4. Claims—Duplicate or redundant

In re Jones, 65 USPQ 480, held that where claim to compound is allowed, claim to insecticidal and fungicidal composition having that compound as active ingredient is not patentable.

### Particular patents—Composition of Matter

Jones, Composition of Matter, claims 1 and 2 of application allowed; claims 6, 7, and 9 to 11 refused.

EXHIBIT

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Appeal from Board of Appeals of the Patent Office.

Application for patent of Franklin D. Jones, Serial No. 393,248, filed May 13, 1941; Patent Office Division 6. From decision rejecting claims 1, 2, 6, 7, and 9 to 11, applicant appeals. Reversed as to claims 1 and 2; affirmed as to remaining claims; Bland, Judge, dissenting in part with opinion.

CAESAR & RIVISE (C. W. RIVISE and A. D. CAESAR of counsel) all of Philadelphia, Pa., for appellant.

W. W. COCHRAN (CLARENCE W. MOORE of counsel) for the Commissioner of Patents.

HATFIELD, Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming the decision of the Primary Examiner rejecting claims 1, 2, 6, 7, 9, 10, and 11 in appellant's application for a patent for an invention relating to a composition of matter.

Claims 1, 2, 6, 7, and 11 are representative of the appealed claims. They read:

1. The substance selected from the group consisting of tetralyl-6-acetonitrile, tetralyl-6-acetic acid, the lower esters and alkali metal salts of said acid, tetralyl-6-acetamide, tetralyl-6-methyl thiocyanate and tetralyl-6-methyl isothiocyanate.

2. Tetralyl-6-acetonitrile.

6. A growth regulating composition for plants having as an active ingredient thereof a substance selected from the group consisting of tetralyl-6-acetonitrile, tetralyl-6-acetic acid, the lower esters and alkali metal salts of said acid, tetralyl-6-acetamide, tetralyl-6-methyl thiocyanate and tetralyl-6-methyl isothiocyanate.

7. A growth regulating composition for plants having as an active ingredient thereof tetralyl-6-acetonitrile.

11. An insecticidal and fungicidal composition having as an active ingredient thereof a substance selected from the group consisting of tetralyl-6-methyl thiocyanate and tetralyl-6-methyl isothiocyanate.

Claims 4 and 5 in appellant's application were allowed by the Board of Appeals. They read:

4. Tetralyl-6-acetamide.

5. The substance selected from the group consisting of tetralyl-6-methyl thiocyanate and tetralyl-6-methyl isothiocyanate.

Claims 1 and 6 were rejected as being drawn to improper Markush groups. Claims 6, 7, 9, 10, and 11 were rejected as being substantial duplicates of claims 1, 2, 4, and 5, as hereinafter explained, and claims 2 and 7 were rejected as being drawn to nonelected species. The Primary Examiner also rejected the claims on prior art, but that rejection was reversed by the Board of Appeals and, therefore, is not before us for consideration.

Appellant's application relates to certain derivatives of tetralin (tetrahydronaphthalene.) It appears from the brief of the Solicitor for the Patent Office, that tetralin is a "naphthalene to which four atoms of hydrogen have been added," the resultant structure "consisting of a benzene ring and a partially saturated six carbon ring, sharing two carbon atoms." In each of the derivatives claimed by appellant, a methyl side chain is attached to the ring structure, the point of attachment being the same in the case of each derivative. All the compounds claimed are said to be effective agents for stimulating plant growth and some of them are stated to be insecticides and fungicides.

Claims 1 and 6 were rejected on the ground that the substances claimed in them are not so related that they can properly be included in a Markush group. The same group is recited in each of those claims and comprises substances of various types, nitriles, acids, alkali metal salts, the lower esters, and thiocyanates. The examiner held that those substances differed from each other to such an extent that they could not properly be included in a single claim. The examiner's decision was affirmed by the Board of Appeals, which stated in its decision that "whether a group is proper must be decided in view of the facts of each particular case." The board concluded that under the circumstances of this case, the substances included in claims 1 and 6 were so different that the examiner's holding was proper.

Counsel for appellant point out in their brief that each of the compounds which are grouped in the appealed claims includes a tetralyl nucleus with a methyl side chain at position 6, and that the tetralyl nucleus is, in each case, the heaviest part of the molecule. Furthermore, each of the compounds is effective as a growth regulating composition for plants.

The Primary Examiner stated that the attached chain portion is of more importance than the nucleus in determining the character of the compound and that the compounds grouped in appealed claims 1 and 6, include acids, salts, es-

ters, and thiocyanates, some of which are "entirely diverse in structure, properties and characteristics."

Whether or not one portion of a compound is considered more important than another depends upon the purpose for which the compound is intended. The side chains of claims 1 and 6 are not the most important factors in determining the molecular weights of the compounds, nor are they the most important factors in determining the value of the compounds in the regulation of plant growth, since the compounds grouped in claims 1 and 6 are all effective plant growth regulators, despite a wide difference in their [1] side chains. In determining the propriety of a Markush grouping, moreover, the compounds which are grouped must each be considered as a whole and should not be broken down into elements or other compounds.

In its decision, the board stated:

In general, the nucleus which is common to all members of the group, imparts similar properties to the members and the substituents impart differentiating properties.

It is evident that in any Markush group, the compounds which are included will differ from each other in certain respects. In determining the propriety of the grouping, these differences must, to some extent, be weighed against the similarities and, as hereinbefore noted, the board pointed out in its decision that "whether a group is proper must be decided in view of the facts of each particular case." The inclusion in Markush groups of compounds which differed widely in some respects, has been permitted. Thus in *Ex parte Clarke* and *Malm*, 1931 C.D. 6, 11 USPQ 52, the Commissioner of Patents permitted the inclusion of aliphatic, aromatic and aralkyl compounds in a single group. In *Ex parte Kendall*, 56 USPQ 119, the Board of Appeals permitted the grouping of substances which varied "in the character of the connecting chain," and in *Ex parte Dahlen et al.*, 1934 C.D. 9, 42 USPQ 208, the board permitted the grouping of compounds having nuclei and side chains, despite the fact that the allowed claims covered a wide variation in the composition of the side chains.

In the instant case no authority was cited by either of the tribunals of the Patent Office in support of the conclusion that the compounds called for by claims 1 and 6 are so dissimilar in their properties as to be repugnant to principles of scientific classification.

In our decision in *In re Swenson et al.*, 30 C.C.P.A. (Patents) 764, 132 F.2d 336, 56 USPQ 180, we approved the Patent

Office practice with respect to claims of the Markush type, as defined in a number of decisions by the Commissioner of Patents, including *Ex parte Burke*, 1934 C.D. 5, 21 USPQ 399, 400. In that case the commissioner said:

The group system was resorted to because of the existence of cases where certain substances, which an inventor by experiment has found available for his purpose, fall within a generic group, but there is nothing to establish that all the species of that group have such similar characteristics as to make them available for this purpose, and there is no known subgeneric term which would include only the species which have been found available.

[2] This language seems to apply to the present situation in which all the claimed compounds belong to the genus of tetralyl compounds having a substituted methyl group at position 6, but it is not established that all members of this genus would be suitable for appellant's purposes. Accordingly, appellant could not properly claim this entire genus and it was necessary to limit his claims to the individual compounds which were known to possess the desired property.

We have carefully considered the views expressed by the Patent Office tribunals, but are of opinion that, under all the circumstances of this case, the substances grouped have "a community of chemical or physical characteristics" which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification, within the meaning of such decisions as *Ex parte Burke*, supra, and *In re Swenson et al.*, supra.

It follows, from what has been said, that claim 1 is allowable and, as that claim is generic, the rejection of claims 2 and 7 on the ground that they are drawn to a non-elected species must be reversed.

There remains to be considered the rejection of claims 6, 7, 9, 10, and 11 on the ground that they are substantial duplicates of other claims. Claim 6 was rejected as a duplicate of claim 1; claim 7 as a duplicate of claim 2; claim 9 as a duplicate of allowed claim 4; and claims 10 and 11 as duplicates of allowed claim 5. Claims 6, 7, 9, and 10 correspond to claims 1, 2, 4, and 5, respectively, except that the claims of the latter group are drawn to compounds per se, whereas the claims of the former group—6, 7, 9, and 10—call for growth regulating compositions having as active ingredients the identical compounds defined in claims 1, 2, 4, and 5, respectively. Similarly, claim

11 calls for an insecticidal and fungicidal composition having as an active ingredient the compound defined in claim 5.

[3] It was held by the Patent Office tribunals, on the authority of *In re Thuau*, 30 C.C.P.A. (Patents) 979, 135 F.2d 344, 57 USPQ 324, that the addition of a statement of use to a claim to a compound does not produce a materially different claim.

Counsel for appellant seek to distinguish this case from *In re Thuau*, supra, on the ground that claims 6, 7, 9, 10, and 11 are not drawn to the compounds of claims 1, 2, 4, and 5, per se, but to growth regulating compositions or insecticidal and fungicidal compositions having those compounds as active ingredients. However, claims 6, 7, 9, 10, and 11 do not state that the growth regulating or insecticidal and fungicidal compositions include anything in addition to the compounds called for in claims 1, 2, 4, and 5. The mere use in claims 6, 7, 9, 10, and 11 of language which is broad enough to permit the inclusion of some unspecified ingredient or ingredients in addition to the compounds of claims 1, 2, 4, and 5, does not justify a holding that the claims of the two groups define different inventions.

[4] The issue presented as to claims 6, 7, 9, 10, and 11 is substantially identical with that in *In re Jones*, 32 C.C.P.A. (Patents) 1020, 149 F.2d 501, 65 USPQ 480. In that case we held that when a claim to a compound had been allowed, a claim to an insecticidal and fungicidal composition having that compound as an active ingredient was not patentable.

For the reasons stated, the decision of the Board of Appeals is modified, being reversed as to claims 1 and 2, and affirmed as to claims 6, 7, 9, 10, and 11.

By reason of illness, GARRETT, Presiding Judge, was not present at the argument of this case and did not participate in the decision.

BLAND, Judge, dissenting in part.

In the next to the last paragraph of the majority opinion is the following sentence:

In that case we held that when a claim to a compound had been allowed, a claim to an insecticidal and fungicidal composition having that compound as an active ingredient was not patentable.

My views as to when a use claim for a patented article or an old article should be allowed are expressed in my concurring opinion in *In re Migrdichian*, 33 C.C.P.A. (Patents) 1224, 156 F.2d 250,

70 USPQ 403. I took the same position with respect to the *Thuau* case, 30 C.C.P.A. (Patents) 979, 135 F.2d 344, 57 USPQ 324, in *In re Haller* (Patent Appeal No. 5273), 34 C.C.P.A. (Patents) 1003, 161 F.2d 280, 73 USPQ 403.

In the instant case the inventor invented a new compound which may have uses of great value other than as an insecticide and fungicide. He also discovered that on plant life it was especially useful. Here he has made two related inventions and he should be allowed claims to the article and to its use if such use is new, unobvious and useful. The public is entitled to his teachings as to use and he is entitled to protection on his discovery as to use.

The particular part of the *Thuau* case which I have urged my associates to modify reads as follows:

The doctrine is so familiar as not to require citation of authority that a patentee is entitled to every use of which his invention is susceptible, whether such use be known or unknown to him. Likewise, with regard to an unpatentable article or substance long in use, *any member of the public has the right to every use of which the article or substance is susceptible so long as it is unchanged in any way, regardless of whether or not such uses were known prior to his own use.* [Italics mine.]

The discovery that sulfur, a very old, unpatented article, was useful in the vulcanization of rubber resulted in a valid patent, and by the same token the discovery that an old article produces new, useful and unobvious results as a fumigant or as a disinfectant may be inventive. The same is true as regards a patented article if the new use claimed is not an obvious one.

31 C.C.P.A. (Patents) 1168

#### Court of Customs and Patent Appeals

In re JONES

Appl. No. 5250 Decided June 17, 1947

#### PATENTS

##### 1. Appeals to Court of Customs and Patent Appeals—Issues to be determined—Ex parte patent cases

Court may not consider on merits claims rejected as not reading on elected species.

# Particular patents—Composition of Matter

Jones, Composition of Matter, claims 1, 2, 4 to 7, 9 to 11, and 15 to 18 of application refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Franklin D. Jones, Serial No. 393,249, filed May 13, 1941; Patent Office Division 6. From decision rejecting claims 1, 2, 4 to 7, 9 to 11, and 15 to 18, applicant appeals. Affirmed.

CAESAR & RIVISE (C. W. RIVISE and A. D. CAESAR of counsel) all of Philadelphia, Pa., for appellant.

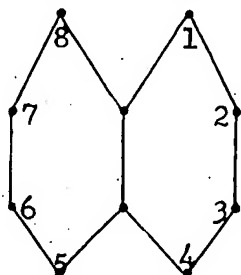
W. W. COCHRAN (CLARENCE W. MOORE of counsel) for the Commissioner of Patents.

JACKSON, Judge.

This is an appeal from a decision of the Board of Appeals of the United States Patent Office affirming that of the Primary Examiner rejecting all of the claims 1, 2, 4, 5, 6, 7, 9, 10, 11, 15, 16, 17 and 18 of an application, Serial No. 393,249, filed May 13, 1941, for a patent relating particularly to compositions derived from either 2-methyl naphthalene or 4-methyl naphthalene, wherein certain radicals are substituted for the hydrogen atom at the 1 position of each composition.

Appellant alleges his compounds to be new and claims they are growth regulating, insecticidal and fungicidal compositions. In the composition claims the compound is the only ingredient recited therein.

Compounds having 2-fused benzene rings, each of which is a 6-carbon ring, with two of the carbons common to both rings, is identified by the term "naphthalene." It is depicted by the drawing (shown below) in the angles of which



are represented the positions of the carbon atoms. The 1, 4, 5 and 8 angles are also designated as alpha positions and the 2, 3, 6 and 7 angles are designated as beta positions.

The derivative compounds of the application have a methyl radical in the 2 and 4 positions, respectively, and at the 1 position have one of the following radicals: aceto-nitrilo ( $-\text{CH}_2\text{-CN}$ ); acetic acid ( $-\text{CH}_2\text{-COOH}$ ); salts of acetic acid ( $-\text{CH}_2\text{-COOM}$ ); esters of acetic acid ( $-\text{CH}_2\text{-COOR}$ ); acetamide ( $-\text{CH}_2\text{-CONH}_2$ ); methyl thiocyanate ( $-\text{CH}_2\text{-SCN}$ ); and methyl isothiocyanate ( $-\text{CH}_2\text{-NCS}$ ).

Claim 15 is illustrative of the subject matter of the rejected claims and reads as follows:

15. The substance selected from the group consisting of 4-methyl naphthyl-1-acetonitrile, 2-methyl naphthyl-1-acetonitrile, 4-methyl naphthyl-1-acetic acid, 2-methyl naphthyl-1-acetic acid, the lower esters and alkali salts of 4-methyl naphthyl-1-acetic acid and 2-methyl naphthyl-1-acetic acid, 4-methyl naphthyl-1-acetamide, 2-methyl naphthyl-1-acetamide, 4-methyl naphthyl-1-methyl thiocyanate, 2-methyl naphthyl-1-methyl thiocyanate, 4-methyl naphthyl-1-methyl isothiocyanate and 2-methyl naphthyl-1-methyl isothiocyanate.

[1] Claims 1, 4, 6, 9, 15, 16, 17 and 18 were rejected as unpatentable over the prior art. Claims 6, 9, 16 and 18 were further rejected as substantial duplicates of claims 1, 4, 15 and 17, respectively. Claims 2, 5, 7, 10 and 11 were rejected as not reading on the elected species. Therefore they may not be considered on their merits here. Claims 1, 6, 15, 16, 17 and 18 were also rejected as containing improper Markush groups.

The prior art cited is as follows:

- Carpmael (Br.), 325,910, 1929.
- Roblin et al., 2,166,554, July 18, 1939.
- Weijlard et al., 2,185,237, January 2, 1940.
- Henry, "Berichte Deut. Chem. Gesell," Vol. 2, page, 637.
- Behrend et al., "Annalen," Vol. 344, pp. 24-5.
- Fries et al., "Annalen," Vol. 470, pp. 34-5.
- Hewett, "Jour. Chem. Soc." (London) 1940, pp. 293-303.

In the patent to Carpmael aromatic compounds are disclosed, containing one or more of the methoxy groups and more than one thiocyanate residue, each of the latter connected to the nucleus through a  $\text{CH}_2$  group, which " \* \* \* are distinguished by an extraordinarily strong insecticidal action."

The Roblin et al. patent relates to the synthesis of naphthaleneacetic acid and naphthyl acetonitrile in the first position.

It is disclosed in the patent that the acid is " \* \* \* one of the plant hormones favoring growth."

The Weijlard et al. patent relates to a process of preparing the nitriles of alpha-naphthyl substituted lower fatty acids substantially free from the beta isomer and discloses naphthyl acetic acid ("1-naphthalenescetic acid" and "alpha-naphthyl acetic acid") and naphthyl acetoneitrile ("alpha-naphthyl acetoneitrile") in the first position.

The Fries et al. reference discloses methyl naphthyl in the first position and acetic acid and the corresponding amide in the second position.

The Hewett publication discloses dimethyl-naphthylacetic acid in the first position and the naphthyl radical in the third and fourth positions, together with the corresponding sodium salt and acetoneitrile.

It is not necessary to discuss the other references.

The compounds of the references are not identical with the claimed compounds. They differ only in the positions of the methyl and acetic acid radicals. In the Fries et al. reference the radicals are reversed in positions from those of the claimed compound and in the Roblin et al. and Weijlard et al. patents the same acetic acid radical is present in the first position, as in the claimed compounds. The difference between the claimed compounds and those of the Roblin et al. and Weijlard et al. compounds is that in the compounds of those references there is no methyl radical. The only difference between the claimed compounds and the compound of the Hewett reference is the presence of an additional methyl radical in the fourth position.

The Primary Examiner stated that when the claimed compound is compared with the compound of the Fries et al. reference, " \* \* \* It will be evident that both contain exactly the same chemical constituents in the same proportion and the two compounds are merely isomers of one another." In other words the compound disclosed in the Fries et al. reference is an isomer of the claimed compound and, therefore, necessarily possesses similar chemical and physical properties.

Appellant contends that the position of the substituted radical is critical, but there are included in the quoted claim alternatively two different positions, the fourth and second, of the methyl group and several of the non-elected claims call for isomers of the substances set out therein.

It will be observed that the compound of the Roblin et al. patent is a hormone which favors the growth of plants and that compound is identified by naphthyl acetic acid in the first position. The same compound is said to possess plant growth properties in the Weijlard et al. patent. The thiocyanate group connected to the nucleus through a  $\text{CH}_2$  group, as disclosed in the patent to Carpmael, is said to possess extremely strong insecticidal properties.

As we view the references, hereinbefore discussed, it seems that there could be nothing unexpected found in the compounds defined by appellant.

We think it should be expected that the compounds of appellant would possess properties regulating the growth of plants such as the compound disclosed in the Roblin et al. and the Weijlard et al. references and that appellant's compound containing the thiocyanate radical would have similar insecticidal and fungicidal properties as the compound of the patent to Carpmael.

Appellant filed an affidavit subsequent to the date of the examiner's statement and prior to the decision of the board the general tenor of which seems to be that any specific compound for the regulation of plant growth, killing insects or fungi may not be accurately predicted. However, as was properly observed by the board in its decision, no comparison was shown in the affidavit to indicate that the compounds of appellant, as generalized in the generic groups, are possessed of any properties differing in kind from the compounds of the references. The board further stated:

Applicant's showing, if it teaches anything, is that the action of compounds is specific—that is, that each individual compound has special properties. None of applicant's claims is specific, but the smallest group (e.g., claim 9) calls for two different compounds, 2-methyl and 4-methyl, which differ as much from one another as they do from the references.

We agree with the tribunals below that in view of the prior art it would be reasonably expected that the appellant's claimed compounds would possess growth regulating, or insecticidal or fungicidal properties. There is nothing in the record, however, to show such unexpected utility in the compounds as would involve invention.

Of course, it is true, as contended by appellant, that " \* \* \* none of the references disclose plant growth regulating, fungicidal and insecticidal activities possessed by one and the same substances."

However, all the claimed compounds of appellant are not claimed by him to possess those three characteristics. It is specifically set forth in the application that, all of the compositions are plant hormones in that they possess the property of influencing, regulating and controlling the growth of plants, but that "thiocyanate and isothiocyanate, in addition to being plant hormones, are very effective as insecticides and fungicides." Both of these compounds are set out in the non-elected species of claim 5.

We are of opinion, in view of what has been said, that generic claim 15 is unpatentable over the prior art. Appellant has made no distinction between the claims and we find no reason to make any such distinction. Therefore, the other generic claims 1, 6 and 16, together with specific claims 4, 9, 17 and 18, fall with the rejection of claim 15.

For the reason that, in our opinion, the claims were properly rejected on the prior art, it is not necessary to discuss the other reasons for rejection given by the tribunals below.

The decision of the Board of Appeals is affirmed.

By reason of illness, GARRETT, Presiding Judge, was not present at the argument of this case and did not participate in the decision.

34 C.C.P.A. (Patents) 1129

## Court of Customs and Patent Appeals

In re HOLT

Appl. No. 5303 Decided June 17, 1947

### PATENTS

#### 1. Patentability—Aggregation or combination—In general

It makes little difference whether any element is new or old if combination of elements involves invention; combination of old elements which produces new, useful, and unobvious results may involve invention and constitute patentable subject matter; question always depends upon particular facts of case.

#### 2. Patentability—Aggregation or combination—In general

Assembling into new article of number of good features of prior art may involve invention and be of such utility

and produce such unexpected results as to be patentable; conception of such structure may be invention, even though assembling into united structure involves little more than mechanical skill after such conception.

#### 3. Patentability—New use or function—Specific cases

Patents relating to shoe repair machinery are analogous to floor surfacing machine; both are in abrading art; that patents do not involve same problems as do floor surfacing machines is considered in determining obviousness in constructing specific floor surfacing machine.

#### 4. Patentability—Aggregation or combination—In general

Court reverses and allows combination claims where applicant brought new functional relationship between parts and elements coact to bring about new and unobvious result; Patent Office should have viewed claims more objectively and less subjectively.

#### 5. Patentability—Evidence of patentability—Commercial success

Evidence of commercial success is important factor to consider where question of presence of invention is in controversy and where there are differences of opinion such as prevail in instant case between those of Patent Office and court.

#### 6. Patentability—Aggregation or combination—In general

It is not enough for rejection that every element is found in prior art, but assembling of them must not involve invention; whether assembly involves invention is question of opinion; it is impossible to definitely establish boundary between invention and lack of invention in cases where uncertainty necessarily exists.

#### 7. Patentability—Aggregation or combination—In general

One may have patent for combination or combined machine which includes patentable subcombination, but claims to combination are refused where better work accomplished is brought about by improvement in subcombination acting in combination in same manner as subcombinations of prior art.

#### Particular patents—Floor Surfacing

Holt, Floor Surfacing Machine, claims 7, 8, 15, 16, and 18 of application allowed; claims 9 and 10 refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of William E. Holt, Serial No. 434,677; Patent Office